

Applic. No. 10/823,986
Amdt. dated January 18, 2006
Reply to Office action of November 18, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-33 remain in the application.

In the second paragraph on page 2 of the above-identified Office action, claims 1-33 have been rejected as being obvious over Breuer et al. (U.S. Patent No. 5,322,672) (hereinafter "Breuer") in view of Wickland (U.S. Patent No. 6,355,078 B1) and further in view of Li et al. (U.S. Patent No. 6,413,589 B1) (hereinafter "Li") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 24 call for, *inter alia*:

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providing at least one covering layer formed with a given porosity and a resistance to temperatures of over 200°C ... and placing at least one fiber layer made of a fiber fabric and having a resistance to temperatures of over 200°C on the at least one covering layer.

It is once again noted that the assignee of the instant application is also the corporate assignee of the Breuer reference. Therefore applicant is very familiar with the Breuer reference.

As will be seen from the following remarks, applicant respectfully disagrees with the Examiner's response to arguments on pages 3-5 of the Office action.

The Breuer reference discloses a honeycomb body assembly made of metal sheets forming a stack with a plurality of channels through which a fluid can flow (abstract).

The Wickland reference discloses a bag for containing nuclear waste including a filter media (52). The filter media (52) is disclosed as being a HEPA filter, the material of the HEPA filter is a proprietary split polypropylene fiber material (column 3, lines 39-42).

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The Li reference discloses a method of coating a ceramic and bonding ceramic to a substrate (abstract).

A person of ordinary skill in the art is not provided with any disclosure as to how the filter media of Wickland is to be made temperature resistant nor are they provided with any disclosure as to how to combine the polypropylene filter media with the metal sheets disclosed by Breuer. Therefore, a person of ordinary skill in the art would be forced to change the polypropylene material of Wickland and to find a method of combining the material of Wickland with the metal sheets of Breuer. Accordingly, it is not obvious for a person of ordinary skill in the art to adopt the filter media of Wickland for modifying Breuer. Therefore, a person of ordinary skill in the art is not provided with any motivation to modify Breuer based on the disclosure of Wickland, to arrive at the present invention as claimed.

Furthermore, the Breuer reference and the Wickland reference are non-analogous art because they meet the criteria they are not from the same field of endeavor and the fact that the Wickland reference is not pertinent to the problem to be solved.

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More specifically, similar to the present invention, the Breuer reference pertains to honeycomb bodies that are used in the exhaust systems of internal combustion engines. However, the Wickland reference pertains to a bag for containing nuclear waste material. Because Breuer pertains to the field of internal combustion engine exhaust system and Wickland pertain to nuclear waste storage, Breuer and Wickland are not from the same field of endeavor. Furthermore, Wickland is not pertinent to the problem to be solved. Particularly, a person of ordinary skill in the art looking for a filter for the honeycomb body of Breuer would look for a filter that has specific properties (i.e. capable of high functioning at high temperature levels, ability to be attached to the metal structure of Breuer, filtering a certain particulate size, etc.). The filter disclosed by Wickland does not meet the specific properties of a filter that would be require and would not be considered or even found by a person of ordinary skill in the art. Accordingly, the Wickland reference does not meet the two criteria for being analogous art. Therefore, the Wickland reference is non-analogous with respect to Breuer and the present invention.

Moreover, applicants respectfully disagree with the Examiner's comments in the last paragraph on page 5 of the Office action pertaining the fiber layer and the cover layer being resistant

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to temperatures of over 200° C. Particularly, the Examiner cites that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The Breuer reference does not satisfy the structural limitations of the instant application and thus Breuer is not a prior art reference that satisfies the structural limitations. It is precisely for this reason that the Examiner uses the Wickland reference in the obviousness rejection. Accordingly, a prior art apparatus does not satisfy the claimed structural limitations. Therefore, it is respectfully believed that the Examiner's remarks pertaining to the cover layer and the fiber layer being resistant to 200° C are not accurate.

Furthermore, a person of ordinary skill in the art is not provided with any motivation to use the disclosure of Lee, directed to a method of coating a ceramic and bonding ceramic to a substrate, to modify the material disclosed in Wickland and implement the material in the assembly disclosed by Breuer.

Moreover, a critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to

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the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998);

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In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

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Applicant respectfully believes that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Upon evaluation of the Examiner's comments, it is respectfully believed that the evidence adduced by the Examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the Examiner is requested to withdraw the rejection.

Since claims 1 and 24 are believed to be allowable, dependent claims 2-23 and 25-33 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 24. Claims 1 and

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24 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 24, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-33 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made..

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Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



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